

REMARKS

Claim Amendments

By this Amendment, Applicant has amended claims 1 and 9, and canceled claim 3 without prejudice or disclaimer of its subject matter. Claims 2, 4, 5, and 10 were previously canceled. The amendments to claim 1 includes features recited in claim 3, now canceled. No new matter has been introduced. Accordingly, claims 1, 6-9, 11, and 12 are pending and under current examination.

Final Office Action

The final Office Action (1) objected to claim 9 because of informalities; and (2) rejected claims 1, 3, 6-9, 11, and 12¹ under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,020,697 (“Goodman”) in view of U.S. Patent No. 5,718,520 (“MacKay”).

Objection to Claim 9

The final Office Action objects to claim 9 because “the punctuation [allegedly] makes the meaning of the claim unclear.” Final Office Action, p. 6. In addition, the “Examiner suggests removing the commas in the first claimed step (i.e. storing a job ticket) to make the meaning of the claim clearer). Without conceding to the final Office Action’s allegations, Applicant has amended claim 9 to improve clarity. Applicant therefore respectfully requests withdrawal of the objection.

Rejection of Claims 1, 3, 6-9, 11, and 12 under 35 U.S.C. § 103(a)

The rejection of claim 3 is moot by virtue of its cancellation. Applicant respectfully traverses the rejection of claims 1, 6-9, 11, and 12 as being unpatentable over Goodman in view

¹ It is a typographical error for the final Office Action to include claims 2, 4, 5, and 10 in the 35 U.S.C. § 103(a) rejection, because these claims have been previously canceled.

of MacKay, because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, the final Office Action must, among other things, properly determine the scope and content of the prior art and properly ascertain the differences between the claimed invention and the prior art. *See* MPEP § 2144.08(II)(A). Furthermore, the final Office Action must provide findings with respect to all of the claim limitations and must provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See Id.* at §§ 2143.03 and 2141(III).

Amended independent claim 1 recites “[a]n image forming apparatus connected to a network,” which includes, among other things, the following features:

a storage section having a first job ticket storing area which is configured to store the job ticket capable of being edited by the operation section, and a second job ticket storing area which is configured to store the job ticket capable of being edited only by the remote operation apparatus.

The final Office Action alleges that Goodman teaches “an image forming apparatus connected to a network,” as recited in claim 1. *See* final Office Action, p. 6. Goodman, however, is a non-analogous reference that cannot be used to reject the claims. The MPEP dictates that “[t]o rely on a reference under 35 U.S.C. § 103, it must be analogous prior art.” MPEP § 2141.01(a)(I).

Goodman is non-analogous because its disclosure is directed to a completely different field of endeavor, a field that is unrelated to the invention recited in claim 1. Claim 1 recites “[a]n image forming apparatus connected to a network.” Examples of the “image forming apparatus” include “a copying machine, a printer, a fax machine, and a scanner, or a composite machine of these.” Specification, p. 1, lines 1-2. Contrary to the final Office Action’s allegation

at p. 6, Goodman does not disclose an image forming apparatus. Rather, Goodman's invention "relates generally to business computing systems, and more particularly to a netcentric execution architecture, a development architecture and an operations architecture that are preferentially used with a netcentric computing system" (emphases added). Goodman, col. 1, lines 13-17. Goodman teaches nothing relating to an image forming apparatus as disclosed and claimed in the present application.

Because Goodman is a non-analogous reference that does not disclose an image forming apparatus, it naturally follows that Goodman does not teach or suggest each and every feature of the image forming apparatus recited in claim 1. The final Office Action alleges that Goodman's "client 78 is equivalent to an image forming apparatus an[d] any one of the second clients 79, 120 [is] equivalent to a remote apparatus." Final Office Action, p. 7. In addition, the final Office Action alleges that Goodman's "information service[s] 64 store[] documents locally and/or remotely such that one local storage and another remote storage are two distinctly separate storage areas [column 76, lines 49-53])," and therefore, they constitute "a first job storing area" and "a second job storing area," as recited in claim 1. *Id.* Applicant respectfully disagrees with the final Office Action's allegations.

First, the final Office Action has mischaracterized Goodman's disclosure. Goodman states that "[c]lients are typically PCs or workstations with a graphical user interface running a web browser." Goodman, col. 3, lines 59-60. Therefore, consistent with Goodman's definition of a client, and contrary to the Office Action's allegations, Goodman's client 78 is not equivalent to an image forming apparatus, but rather, is a PC or a workstation with a graphical user interface running a web browser.

Second, claim 1 recites that “a first job ticket storing area” and “a second job ticket storing area” are included in a storage section of an image forming apparatus. In contrast, Goodman’s information services 64 are not even included in the same apparatus. As shown in Fig. 5 of Goodman, one information service 64 is included in client 78, and the other information service 64 is included in server 80. Furthermore, neither of the information services 64 shown in Figs. 5 and 7 constitutes “a second job ticket storing area which is configured to store the job ticket capable of being edited only by the remote operation apparatus,” as recited in amended claim 1 (emphasis added). The final Office Action alleges that “any one of the second clients 79, 120 [is] equivalent to a remote apparatus.” Final Office Action, p. 7. However, even assuming for the sake of argument that any one of the second clients 79 and 120 is a remote apparatus, an allegation to which Applicant does not accede, Goodman does not teach or suggest that any of the information services 64 is configured to store the job ticket capable of being edited only by client 79 or 120. Therefore, the information services 64 of Goodman do not constitute “a first job ticket storing area” and “a second job ticket storing area which is configured to store the job ticket capable of being edited only by the remote operation apparatus,” as recited in amended claim 1 (emphasis added).

In summary, because Goodman lacks teachings related to an image forming apparatus, as discussed above, Goodman is non-analogous art. One of ordinary skill in the art of image forming apparatus would not logically refer to Goodman’s architecture for a netcentric computing system in order to solve problems related to editing a job ticket in an image forming apparatus. The final Office Action therefore cannot properly rely on Goodman as prior art under 35 U.S.C. § 103. Moreover, even assuming the final Office Action can rely on Goodman,

Goodman still does not teach or suggest each and every feature of amended claim 1, as discussed above.

The final Office Action relies on MacKay to allegedly cure the deficiencies of Goodman. The final Office Action alleges that MacKay discloses “a storage section having a first job storing area . . . and a second job storing area,” as recited in claim 1, and refers to Fig. 7 for its disclosure of a “job file 155,” and Figs. 1 and 2 for its disclosure of an “image input section 4,” which has “both remote and on-site image inputs which enables system 2 to provide a network printing system with remote input.” Final Office Action, p. 10. Applicant disagrees with the final Office Action’s allegations. MacKay’s image input section 4 is a section for inputting “image data in the form of image signals or pixels from one or more remote sources to . . . system 2 for processing,” when image input section 4 is used for off-site image input. MacKay, col. 3, lines 61-65. With respect to the job file 155, MacKay merely teaches that the job file 155 is configured to store a list of jobs 156. *See* MacKay, Fig. 7. Although Fig. 11 of MacKay teaches editing print jobs, MacKay, however, does not teach or suggest that the job file 155 includes “a second job ticket storing area which is configured to store the job ticket capable of being edited only by the remote operation apparatus,” as recited in amended claim 1 (emphasis added).

For at least the foregoing reasons, Goodman and MacKay are not combinable because Goodman is a non-analogous reference that teaches nothing related to an image forming apparatus connected to a network. Furthermore, even assuming for the sake of argument that Goodman and MacKay are combinable, as alleged by the final Office Action at p. 11, the alleged combination still fails to teach or suggest the features recited in amended independent claim 1. Moreover, the undisclosed features represent significant differences between the claimed

invention and the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1, and it is allowable over the cited references.

Although of different scope, each of independent claims 9 and 11 recites features similar to those recited in claim 1, and thus, is allowable over the cited references for at least the same reasons as discussed above with respect to claim 1. Dependent claims 6-8, and 12 are also allowable at least by virtue of their dependence from claim 1, as well as by their recitation of additional features not taught or suggested by the cited references. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 6-9, 11, and 12.

Conclusion

In view of the foregoing remarks, Applicant submits that the subject matter of claims 1, 6-9, 11, and 12 is not rendered obvious by the cited references, and therefore, is allowable. Applicant therefore requests entry of this Amendment under 37 C.F.R. § 1.116, placing claims 1, 6-9, 11, and 12 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 6-9, 11, and 12 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final Office Action presents some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

The final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 12, 2010

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